

ESTTA Tracking number: **ESTTA712430**

Filing date: **12/03/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91216077
Party	Defendant Future Payment Technologies, L.P.
Correspondence Address	JASON R FULMER GARDERE WYNNE SEWELL LLP 1601 ELM STREET, SUITE 3000 DALLAS, TX 75201-4761 UNITED STATES ip@gardere.com, jfulmer@gardere.com, kschwartz@gardere.com, ploh@gardere.com, sbutler@gardere.com
Submission	Motion to Quash
Filer's Name	Jason R. Fulmer
Filer's e-mail	jfulmer@gardere.com, ip@gardere.com, ploh@gardere.com, kschwartz@gardere.com, sbutler@gardere.com
Signature	/Jason R. Fulmer/
Date	12/03/2015
Attachments	FTP-Motion to Quash.pdf(394829 bytes)

¹ A copy of the TTAB's grant of FPT's consented motion to suspend proceedings is attached as exhibit A.

2. On November 23, 2015, Opposer RevenueWire, Inc. (“RevenueWire”) noticed the deposition of (i) FPT (through a corporate representative) on December 7, 2015,² (ii) Chris Dierks on December 8, 2015,³ and (iii) Jason Fulmer, on December 9, 2015.⁴ RevenueWire noticed each deposition to occur at the offices of Advantim IP LLP (the “Advantim Office”), which is located in Chicago, Illinois. FPT, Mr. Dierks, and Mr. Fulmer are all based in the Dallas, Texas, area. Mr. Fulmer is a partner at the law firm of Gardere Wynne Sewell LLP and one of FPT’s outside lawyers.

3. RevenueWire did not consult with FPT concerning the witnesses it seeks to depose or the location or timing of the depositions.

4. On or about November 20, 2015, RevenueWire served FPT with its Amended Complaint in a case styled as *RevenueWire, Inc. v. Future Payment Technologies, L.P.* in the U.S. District Court for the Northern District of Illinois.⁵

5. The Board should quash these depositions because, among other reasons, they are outside the discovery period in this case. In the alternative, the Board should issue a protective order preventing any attempt by RevenueWire to depose Mr. Fulmer and require that the depositions of FPT’s corporate representative and Mr. Dierks take place in Dallas, Texas, at a mutually convenient time and place pursuant to a new scheduling order.

II. Argument & Authorities

A. Request to Quash

6. FPT requests that the Board quash the notices of deposition. A party may file a motion, prior to the taking of the noticed discovery deposition, to quash the notice of deposition. TBMP § 521. Because each notice is untimely, includes an improper location, fails to give reasonable

² A copy of the deposition notice for the corporate representative for FPT is attached as exhibit B.

³ A copy of the deposition notice for Chris Dierks is attached as exhibit C.

⁴ A copy of the deposition notice for Jason Fulmer is attached as exhibit D.

⁵ FPT reserves its right to challenge the sufficiency of service pursuant to Rule 12 of the Federal Rules of Civil Procedure

notice, and, as to Jason Fulmer, counsel for FPT, is improper and without a proper basis, the Board should quash the notices of deposition of FPT, Chris Dierks, and Jason Fulmer.

7. First, FPT objects that the proposed depositions are untimely. *See* TBMP § 521 (explaining that a “party may move to quash a notice of deposition on the ground that . . . the proposed deposition is untimely . . .”). A discovery deposition must be taken on or before the closing date of the discovery period. *See* 37 C.F.R. § 2.120(a)(3); TBMP § 404.01. Here, RevenueWire noticed the depositions during the discovery period—on November 23, 2015. But RevenueWire noticed the depositions to occur after the close of the discovery period—on December 7, 8, and 9, 2015. *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852 (TTAB2008) (motion to quash granted on deposition noticed during discovery but scheduled after close of discovery); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978) (motion to quash granted where party noticed deposition for a date after the discovery period expired). FPT and RevenueWire have not stipulated—and the Board has not allowed—discovery to occur outside the discovery period. Because RevenueWire noticed the depositions to occur outside the discovery period, the Board should quash the notices of deposition. *See Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978) (discovery may not be taken outside the discovery period).

8. Second, FPT objects to the location included in the notices of deposition. *See* TBMP § 521 (explaining that a “party may move to quash a notice of deposition on the ground that . . . in the case of a discovery deposition to be taken in the United States, the deposition is not scheduled to be taken in the Federal judicial district where the proposed deponent resides or is regularly employed . . .”). “The deposition of a natural person shall be taken in the Federal judicial district where the person resides or is regularly employed” 37 C.F.R. § 2.120(b). And, generally, the deposition of a corporation by its agents and officers should be taken at the corporation’s principal place of business. *See Salter v. Upjohn Co.*, 593 F.2d 649, 651 (5th Cir.1979)(“It is well settled that

‘(t)he deposition of a corporation by its agents and officers should ordinarily be taken at its principal place of business,’ especially when, as in this case, the corporation is the defendant.”); *Chris-Craft Indust. Prod., Inc. v. Kuraray Co., Ltd.*, 184 F.R.D. 605, 607 (N.D.Ill. 1999)(“The general rule is that the deposition of a corporation by its agents and officers should be taken at the corporation’s principal place of business.”). Here, RevenueWire noticed the depositions to occur at the Advantim Office. The Advantim Office is located in Chicago, Illinois and in the Northern District of Illinois. Neither Mr. Dierks nor Mr. Fulmer reside or are regularly employed in the Northern District of Illinois. Additionally, FPT’s principal place of business is not located in Chicago, Illinois. Because RevenueWire noticed the depositions to occur at an improper location, the Board should quash the notices of deposition.

9. Third, FPT objects that RevenueWire failed to give reasonable notice. *See* TBMP § 521 (explaining that a “party may move to quash a notice of deposition on the ground that . . . that there was not due (i.e., reasonable) notice of the proposed deposition . . . “). “A party who wants to depose a person by oral questions must give reasonable written notice to every other party.” TBMP § 404.06(a). RevenueWire noticed these depositions without conferring with FPT. *See* TBMP § 404.01 (explaining that “as a matter of convenience and courtesy and to avoid scheduling conflicts, the parties should attempt to schedule depositions by agreement rather than having the deposing party unilaterally set a deposition date.”). The Board “strongly recommend[s] that the deposing party contact the party sought to be deposed (or whose officer, director, etc., is sought to be deposed) well in advance of the proposed deposition in order to arrange a mutually convenient time for the deposition.” TBMP § 404.05. Additionally, the Board explains that “[t]he closing of a party’s discovery period does not constitute a compelling need for failing to provide reasonable notice of deposition.” *Id.* (citing *Gaudreau v. American Promotional Events Inc.*, 82 USPQ2d 1692, 1696 (TTAB 2007)). Here, RevenueWire never attempted to arrange a mutually convenient time or location for

the deposition. Instead, RevenueWire waited until the last week of the discovery period to unilaterally notice each deposition (for a date outside the discovery period). Because RevenueWire unilaterally noticed the depositions to occur on dates (and in locations) on which the witnesses are unavailable, the Board should quash the notices of deposition.

10. Fourth, FPT objects that the deposition of Jason Fulmer is improperly noticed and without proper basis. *See* TBMP § 521 (explaining that a “party may move to quash a notice of deposition on the ground that . . . [it] is without proper basis . . .”). “Deposition of a nonparty witness residing in the United States may be taken by subpoena under 35 U.S.C. § 24 and Fed. R. Civ. P. 45, or on notice alone, if the nonparty witness agrees to appear voluntarily.” *See* TBMP § 404.02. Here, Mr. Fulmer (i) represents FPT in this proceeding, (ii) is not a party to the proceedings, (iii) is not an officer, director, or managing agent of a party, (iv) is not a person designated under Rule 30(b)(6) or Rule 31(a), and (v) has not voluntarily agreed to appear for a deposition. It is RevenueWire’s sole responsibility to secure Mr. Fulmer’s attendance at a deposition, which, absent Mr. Fulmer’s agreement, must be done by subpoena. *Id.*; 37 C.F.R. § 2.120(b) (“The responsibility rests wholly with the party taking discovery to secure the attendance of a proposed deponent other than a party or anyone who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure.”). Additionally, Mr. Fulmer’s deposition is unreasonable, harassing, burdensome, and seeks to invade the attorney-client privilege. “[F]ederal courts have disfavored the practice of taking the deposition of a party’s attorney; instead, the practice should be employed only in limited circumstances.” *Theriot v. Parish of Jefferson*, 185 F.3d 477, 491 (5th Cir.1999). “In order to depose opposing counsel, the party seeking to take the deposition must show that (1) no other means exist to obtain the information than to depose the opposing counsel; (2) the information sought is relevant and non-privileged; and (3) the information is crucial to the preparation of the

case.” *Nguyen v. Excel Corp.*, 197 F.3d 200, 209 (5th Cir.1999) (citing *Shelton v. American Motors Corp.*, 805 F.2d 1323, 1327 (8th Cir.1986)). RevenueWire has not demonstrated any of the necessary factors. Because it is improperly noticed and without proper basis, the Board should quash the notice of Mr. Fulmer’s deposition

B. Request for Protection

11. Alternatively, FPT requests that the Board enter a protective order. TBMP § 521. Upon motion by a party from whom discovery is sought, and for good cause shown, the Board may make any order which justice requires protecting a party from annoyance, embarrassment, oppression, undue burden, or expense. 37 C.F.R. 2.120(f). The Board may enter a protective order forbidding the discovery; specifying terms, including time and place, for the discovery; and forbidding inquiry into certain matters or limiting the scope of discovery to certain matters. *See* Fed. R. Civ. P. 26(c)(1); 37 C.F.R. § 2.120(f).

12. First, FPT seeks a protective order that forbids the discovery depositions. RevenueWire unilaterally noticed the depositions to be taken in the Advantim Office on December 7, 8, and 9, 2015. As explained above, the depositions should be forbidden because RevenueWire noticed them to occur on a date outside the discovery period and in an improper location. *See* 37 C.F.R. §§ 2.120(a)(3), (b); TBMP § 404.01; *see Upjohn Co.*, 593 F.2d at 651; *see also Chris-Craft*, 184 F.R.D. at 607. If the Board permits the depositions, each of the depositions should be scheduled at a mutually agreeable time in Dallas, Texas. *See id.*

13. Second, FPT seeks a protective order that forbids the deposition of Mr. Fulmer. RevenueWire must secure Mr. Fulmer’s attendance at a deposition by subpoena. And, to depose Mr. Fulmer, who is counsel for FPT, RevenueWire must demonstrate the factors identified above. *See Nguyen*, 197 F.3d at 209. Because RevenueWire has not obtained a subpoena and has not, and

cannot, demonstrate the necessary factors, the Board should enter a protective order forbidding Mr. Fulmer's deposition.

14. Counsel for FPT notified counsel for RevenueWire of these issues and asked that RevenueWire work with FPT to resolve these issues without involvement of the Board. To date, RevenueWire has not responded to FPT's request.

15. FPT respectfully requests that the Board consider and rule on this motion by telephonic conference prior to December 7, 2015, which is the date on which RevenueWire unilaterally noticed the deposition of a corporate representative of FPT. *See* 37 C.F.R. § 1.120(i)(1); TBMP § 413.01.

III. Relief Requested

16. FPT moves the Board for an order quashing the notices of deposition served by RevenueWire on November 23, 2015, for FPT, Chris Dierks, and Jason Fulmer; and, in the alternative, FPT moves the Board for a protective order directing that (a) RevenueWire confer with FPT's counsel regarding a mutually agreeable time and location for the requested depositions of FPT and Mr. Dierks upon entry of an amended scheduling order in this case; and (b) forbidding the deposition of Mr. Fulmer.

Date: December 3, 2015

Respectfully submitted,

/s/ Peter L. Loh

Peter L. Loh

Texas State Bar No. 24036982

Kay Lyn Schwartz

State Bar No. 17865700

kschwartz@gardere.com

Jason R. Fulmer

State Bar No. 24032326

jfulmer@gardere.com

Sadie F. Butler

State Bar No. 24085234

sbutler@gardere.com

GARDERE WYNNE SEWELL, LLP

1601 Elm Street, Suite 3000

Dallas, Texas 75201

(214) 999-3000

(214) 999-4667 (fax)

**ATTORNEYS FOR APPLICANT
FUTURE PAYMENT TECHNOLOGIES, L.P.**

CERTIFICATE OF CONFERENCE

On November 24, 2015, counsel for FPT notified counsel for RevenueWire of these issues and asked that RevenueWire work with FPT to resolve these issues without involvement of the TTAB. To date, RevenueWire has not responded to FPT's request.

/s/ Peter L. Loh
Peter Loh

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was served upon counsel for RevenueWire as indicated below on December 3, 2015.

Michelle S. Katz
ADVITAM IP LLP
160 N. Wacker Drive
Chicago, IL 60606
mkatz@ADVITAMIP.com

/s/ Peter L. Loh
Peter Loh

EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: October 2, 2015

Opposition No. 91216077

RevenueWire, Inc.

v.

Future Payment Technologies, L.P.

Nicole Thier, Paralegal Specialist:

Opposer/counterclaim defendant's consented motion (filed September 28, 2015) to suspend this proceeding for 30-days is granted.

Proceedings are suspended until October 29, 2015, subject to the right of either party to request resumption at any time. *See* Trademark Rule 2.117(c), and 2.127(a); and TBMP § 605.02).

In the event that there is no word from either party concerning the progress of their negotiations, upon conclusion of the suspension period, proceedings shall resume without further notice or order from the Board, upon the schedule set forth below.

Proceedings Resume	October 30, 2015
Discovery Closes	November 29, 2015
Plaintiff's Pretrial Disclosures	January 13, 2016
30-day testimony period for plaintiff's testimony to close	February 27, 2016
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	March 13, 2016

30-day testimony period for defendant and plaintiff in the counterclaim to close	April 27, 2016
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	May 12, 2016
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	June 26, 2016
Counterclaim Plaintiff's Rebuttal Disclosures Due	July 11, 2016
15-day rebuttal period for plaintiff in the counterclaim to close	August 10, 2016
Brief for plaintiff due	October 9, 2016
Brief for defendant and plaintiff in the counterclaim due	November 8, 2016
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	December 8, 2016
Reply brief, if any, for plaintiff in the counterclaim due	December 23, 2016

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If, during the suspension period, either of the parties or their attorneys should have a change of address, the Board should be so informed.¹

¹ If the parties are (or during the pendency of this proceeding become) parties to another proceeding involving the subject application/registration, the parties must notify the Board so the Board can consider whether consolidation or suspension of proceedings is appropriate.

EXHIBIT B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application)	
Serial Nos. 85/860,106 and 85/860,109)	
Filed February 26, 2013)	
For the mark "FUTURE PAYTECH" and)	
"FUTURE PAYMENT TECHNOLOGIES")	
Published February 25, 2014)	
)	
RevenueWire Inc.,)	
)	Opposition No. 91216077
Opposer)	
)	
v.)	
)	
Future Payment Technologies, L.P.)	
)	
Applicant.)	

OPPOSER'S 30(b)(6) NOTICE OF DEPOSITION

PLEASE TAKE NOTICE that pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure and 37 C.F.R. § 2.120(b), Opposer REVENUEWIRE, INC., will take the deposition upon oral examination of Applicant FUTURE PAYMENT TECHNOLOGIES, L.P., by and through its officers, directors, managing agents, or other persons designated as being competent to testify on behalf of Applicant with respect to the matters set forth in the attached Schedule A, before a Notary Public or another person qualified by law to administer oaths. The depositions shall commence at 9:30 a.m. on December 7, 2015 or on another day that is convenient for the parties in the offices of Advitam IP, LLC. The deposition(s) will continue from day-to-day until completed. The deposition(s) may be recorded by stenographic, audio, and video or other means. You are invited to attend and cross-examine.

Dated: November 23, 2015

Respectfully Submitted,

RevenueWire, Inc.

By: /s/ Michele S. Katz/
Michele S. Katz, Esq.
Advitam IP, LLC
160 N. Wacker Drive
Chicago, Illinois 60606
(312) 332-7710
Mkatz@advitamip.com

Attorney for Opposer
RevenueWire, Inc.

SCHEDULE A

Opposer incorporates by reference the definitions and instructions set forth in Opposer's First Set of Interrogatories.

1. Applicant's selection, adoption, and clearance of Applicant's Marks.
2. Applicant's past, current, and future intended use, advertising, and promotion of Applicant's Marks.
3. Information and facts regarding Applicant's knowledge of the earliest dates of use of Applicant's Marks.
4. Market research and business plans, including but not limited to those relating to Applicant's Mark and/or the products identified by Applicant's Marks.
5. Applicant's domain name www.futurepaytech.com.
6. The manner in which Applicant receives and processes consumer inquiries, comments, and/or complaints.
7. Applicant's knowledge of third party trademarks, service marks, and trade names, containing the terms "FUTURE" and "PAY" or any variation of the terms, including but not limited to marks Applicant intends to rely upon in this action.
8. All interaction and communication with third-parties relating to Opposer and/or Opposer's Mark.
9. All allegations and denials that Applicant asserts and intends to assert in this case, including but not limited to those set forth in Applicant's Answer.
10. Applicant's knowledge of Opposer, its products and services, and Opposer's Mark.
11. Any instances of actual confusion between Applicant's Marks and Opposer's Mark.
12. Applicant's document retention policy and its compliance with discovery.
13. Revenues derived from the sale of products and services bearing Applicant's Marks.
14. The documents responsive to Opposer's written discovery dated December 22, 2014.

CERTIFICATE OF SERVICE

I hereby certify that on this 23rd day of November 2015, I have served a true and correct copy of the foregoing OPPOSER'S 30(b)(6) NOTICE OF DEPOSITION via email to:

GARDERE WYNNE SEWELL LLP
1601 Elm Street, Suite 3000
Dallas, Texas 75201
Tel:214-999-3000
Fax:214-999-3623
Email: ip@gardere.com; kschwartz@gardere.com;
jfulmer@gardere.com; ploh@gardere.com

ATTORNEYS FOR APPLICANT

/s/ Michele S. Katz/

Attorney for Opposer

EXHIBIT C

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application)	
Serial Nos. 85/860,106 and 85/860,109)	
Filed February 26, 2013)	
For the mark "FUTURE PAYTECH" and)	
"FUTURE PAYMENT TECHNOLOGIES")	
Published February 25, 2014)	
)	
RevenueWire Inc.,)	
)	Opposition No. 91216077
Opposer)	
)	
v.)	
)	
Future Payment Technologies, L.P.)	
)	
Applicant.)	

NOTICE OF DEPOSITION OF CHRIS DIERKS

PLEASE TAKE NOTICE that Opposer REVENUEWIRE, INC. will take the deposition upon oral examination of Chris Dierks before a Notary Public or another person qualified by law to administer oaths. The depositions shall commence at 9:30 a.m. on December 8, 2015 or on another day that is convenient for the parties in the offices of Advitam IP, LLC. The deposition(s) will continue from day-to-day until completed. The deposition(s) may be recorded by stenographic, audio, and video or other means. You are invited to attend and cross-examine.

Dated: November 23, 2015

Respectfully Submitted,

RevenueWire, Inc.

By: /s/ Michele S. Katz/

Michele S. Katz, Esq.

Advitam IP, LLC

160 N. Wacker Drive

Chicago, Illinois 60606

(312) 332-7710

Mkatz@advitamip.com

Attorney for Opposer

RevenueWire, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on this 23rd day of November 2015, I have served a true and correct copy of the foregoing NOTICE OF DEPOSITION OF CHRIS DIERKS via email to:

GARDERE WYNNE SEWELL LLP
1601 Elm Street, Suite 3000
Dallas, Texas 75201
Tel:214-999-3000
Fax:214-999-3623
Email: ip@gardere.com; kschwartz@gardere.com;
jfulmer@gardere.com; ploh@gardere.com

ATTORNEYS FOR APPLICANT

/s/ Michele S. Katz/
Attorney for Opposer

EXHIBIT D

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application)	
Serial Nos. 85/860,106 and 85/860,109)	
Filed February 26, 2013)	
For the mark "FUTURE PAYTECH" and)	
"FUTURE PAYMENT TECHNOLOGIES")	
Published February 25, 2014)	
)	
RevenueWire Inc.,)	
)	Opposition No. 91216077
Opposer)	
)	
v.)	
)	
Future Payment Technologies, L.P.)	
)	
Applicant.)	

NOTICE OF DEPOSITION OF JASON FULMER

PLEASE TAKE NOTICE that Opposer REVENUEWIRE, INC. will take the deposition upon oral examination of Jason Fulmer before a Notary Public or another person qualified by law to administer oaths. The depositions shall commence at 9:30 a.m. on December 9, 2015 or on another day that is convenient for the parties in the offices of Advitam IP, LLC. The deposition(s) will continue from day-to-day until completed. The deposition(s) may be recorded by stenographic, audio, and video or other means. You are invited to attend and cross-examine.

Dated: November 23, 2015

Respectfully Submitted,

RevenueWire, Inc.

By: /s/ Michele S. Katz/
Michele S. Katz, Esq.
Advitam IP, LLC
160 N. Wacker Drive
Chicago, Illinois 60606
(312) 332-7710
Mkatz@advitamip.com

Attorney for Opposer
RevenueWire, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on this 23rd day of November 2015, I have served a true and correct copy of the foregoing NOTICE OF DEPOSITION OF JASON FULMER via email to:

GARDERE WYNNE SEWELL LLP
1601 Elm Street, Suite 3000
Dallas, Texas 75201
Tel:214-999-3000
Fax:214-999-3623
Email: ip@gardere.com; kschwartz@gardere.com;
jfulmer@gardere.com; ploh@gardere.com

ATTORNEYS FOR APPLICANT

/s/ Michele S. Katz/
Attorney for Opposer